



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/918,652	03/22/2000	Wen-Chen Su	AVERYRC.SPCPI	9479

7590 05/18/2005

CASELLA & HESPOS LLP
274 Madison Avenue - Suite 1703
New York, NY 10016

EXAMINER

NORDMEYER, PATRICIA L

ART UNIT	PAPER NUMBER
----------	--------------

1772

DATE MAILED: 05/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

YH
m

Office Action Summary	Application No.	Applicant(s)	
	09/918,652	SU ET AL.	
	Examiner	Art Unit	
	Patricia L. Nordmeyer	1772	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 April 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 12-14 and 21-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 12-14 and 21-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

re

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on April 1, 2005 has been entered.

37 CFR 1.132 Declaration

2. The declaration under 37 CFR 1.132 April 1, 2005 is insufficient to overcome the rejection of claims 12 – 14 and 21 – 26 based upon the disclosure of Reed (U.S. Patent No. 5,229,212) as set forth in the last Office action.

The results presented by Ms. Adrian Hulme are not commensurate in scope with the claimed invention. While the samples tested between the Applicant's claimed invention and the examples in Reed are commensurate in scope with each other, there is no nexus between the information found from the tested examples and claimed invention. The claimed limitations directed towards the pressure-sensitive label are silent with regard to the anchorage percentages, or unexpected results, presented. Therefore, the declaration fails to be commensurate in scope with the claimed invention and fails to overcome the rejection over the disclosure of Reed.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 12, 21 – 24, 27 and 30 are rejected under 35 U.S.C. 102(b) as being anticipated by Reed (USPN 5,229,212).

Reed discloses a multi-layer release liner comprising a backing (“paper and paperboard”; Col. 7, lines 49-50), a support layer covering the backing (“precoated with a suitable coating such as clay”; Col. 7, lines 50-52), and a silicone-containing layer covering the support layer (Col. 7, lines 49-50). Reed further discloses that in the preferred embodiment, the silicone release composition is an aqueous dispersion containing from 10 to 98% by weight of a curable silicone, about 1 to 10% by weight of a crosslinking catalyst, and about 0.01 to 30% by weight of a water soluble polyethylene oxide (Col. 4, lines 45-52) – thus, Reed discloses that the solids of the release layer are formed in part of silicone, and depending on the desired end product, may be formed by substantially all silicone (upwards of 98%). Reed discloses functionally equivalent methods to those of the Applicants of applying the silicone layer to the backing layer, including curtain coating (Col. 6, lines 61-66), but note, however, that the method of forming has not been given patentable weight. Reed discloses that the silicone coating is coated with a coat weight as low as possible without sacrificing the efficacy for cost effectiveness (Col. 7, lines 6-8) and that the use of the polyethylene oxide as a “polymeric thickener” in the silicone emulsion has shown

Art Unit: 1772

enhanced holdout properties -- "holdout" referring to the amount of the silicone which does not penetrate into the porous substrate and remains on the surface of the substrate to serve as a release coating (Col. 7, line 59 to Col. 8, line 14). Specifically, Reed discloses that the release surface comprises between 54 and 81% of the silicone (see Table 3; Col. 10, lines 14-23). Therefore, since over 50% of the silicone is contained within the release surface, the liner inherently exhibits a non-linear distribution of silicone and the most silicone that may possibly be contained at the first micrometer depth below the release surface is 46% -- thus, the release liner is non-linear throughout the release liner and a lower amount of silicone is present in each successive 1 micrometer depth. This non-linearity is hypothesized to occur based on the polyethylene oxide bonding to hydrogen bonding sites of the substrate and reducing the penetration of the silicone into the substrate (Col. 8, lines 2-4). Ultimately, the release liner is further incorporated into a pressure-sensitive adhesive label construction (Col. 9, lines 9-14). The backing has small pores and openings that the support layer fills (Column 8, lines 13)

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 13, 14, 25 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reed (USPN 5,229,212).

Art Unit: 1772

Reed teaches a multi-layer release liner as detailed above. Reed further teaches that the peel release force is measured with a 140° release test wherein the sheet was pulled on an Instron instrument at 8 inches per minute (Col. 9, lines 16-21). Since the aforementioned testing procedure is not equivalent to that disclosed by the Applicant, it is unascertainable whether the liner in Reed teaches an equivalent release property value to that claimed by the Applicant. Based on the material disclosures along with the functionally equivalent method of forming and anticipation of the high concentration of silicone on the release surface, however, the release force values are inherently the same. Even if not inherently equivalent, Reed teaches that the release properties of the coated paper are a function of the amount of silicone remaining on the surface of the paper (Col. 10, lines 30-33) which may be modified based on the coat weight and composition of the silicone coating. Therefore, it would have been obvious to one of ordinary skill in the art at the time Applicant's invention was made to have modified either the coat weight or composition taught by Reed such that the release properties of the liner fell within the Applicant's claimed range, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

7. Claims 28 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reed in view of Freedman (USPN 4,713,273).

Reed teaches a multi-layer release liner as detailed above except for the support layer including a filler material selected for substantially sealing the small pores in the backing while

Art Unit: 1772

being a material capable of being expressed from a dual-die and wherein the filler material of the support layer comprises latex.

Freedman teaches a multi-layer release liner (Column 11, line 56) where support layer including a filler material selected for substantially sealing the small pores in the backing while being a material capable of being expressed from a dual-die (Column 11, lines 61 – 62) and wherein the filler material of the support layer comprises latex (Column 3, lines 15 – 19) for the purpose of forming a face stock that has from the filler material which helps resist curling in the material.

It would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have provided the filler material made from latex in the support material in Reed in order to form a face stock that has from the filler material which helps resist curling in the material as taught by Freedman.

Response to Arguments

8. Applicant's arguments filed April 1, 2005 have been fully considered but they are not persuasive.

In response to Applicant's argument that there is nothing in Reed to suggest that the release layer of Reed could somehow create an irregular interface with the clay coating that the Examiner compares to the claimed support layer or that the claimed dispersal of the release layer into the support layer would not appear to occur, Reed discloses that the silicone has an

Art Unit: 1772

improved holdout, wherein holdout is defined to be the amount of silicone that does not penetrate into the porous substrate and remains on the surface of the substrate (Column 8, lines 11 – 14).

This would lead one of ordinary skill in the art to the understanding that an irregular interface is formed with the clay coating since the amount of silicone that penetrates would not be consistent over the whole surface.

Conclusion


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patricia L. Nordmeyer whose telephone number is (571) 272-1496. The examiner can normally be reached on Mon.-Thurs. from 7:00-4:30 & alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Y. Pyon can be reached on (571) 272-1498. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Patricia L. Nordmeyer
Examiner
Art Unit 1772

pln


HAROLD PYON
SUPERVISORY PATENT EXAMINER
1772

5/13/05